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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,075	02/19/2002	Ronald C. Montelaro	A34001-A/072396.0222	4545

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BAKER & BOTTS  
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NEW YORK, NY 10112

EXAMINER
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LIU, SAMUEL W

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/079,075

Applicant(s)

MONTELARO ET AL.

Examiner

Samuel W Liu

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 8--65 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 8--65 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 8-41, drawn to the peptide, a composition comprising the peptide, and a solid phase comprising the peptide, are classified in class 530, subclass 300.
- II. Claims 42-43 and 48-50, 56 and 62, drawn to a method of inhibiting (in vitro) bacterial growth comprising administering to a mammalian cell the peptide, are classified in class 514, subclass 2, class 424, subclasses 409, 9.322 and 9.37.
- III. Claims 42-43 and 48-50, 56 and 62, drawn to a method of inhibiting (in vitro) fungal growth comprising administering to a mammalian cell the peptide, are classified in class 514, subclass 2, class 424, subclasses 409, 9.322 and 9.37.
- IV. Claims 42-43 and 48-50 and 56, drawn to a method of inhibiting (in vitro) virus growth comprising administering to a mammalian cell the peptide, are classified in class 514, subclass 2, class 424, subclasses 409, 9.322 and 9.37.
- V. Claims 51-53, drawn to a method of suppressing HIV-1 infectivity (in vitro) comprising administering to a mammalian cell the peptide, are classified in class 514, subclass 2, class 424, subclasses 185.1, 188.1, 9.322 and 9.37.
- VI. Claims 54-57 and 61, drawn to a method of inhibiting (in vivo) bacterial growth comprising administering to a subject the peptide, are classified in class 514, subclass 2, class 424, subclasses 409, 9.322 and 9.37.
- VII. Claims 54-57 and 61, drawn to a method of inhibiting (in vivo) fungal growth comprising administering to a subject the peptide, are classified in class 514, subclass 2, class 424, subclasses 409, 9.322 and 9.37.

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- VIII. Claims 54-61, drawn to a method of inhibiting (in vivo) virus growth comprising administering to a subject the peptide, are classified in class 514, subclass 2, class 424, subclasses 185.1, 188.1, 9.322 and 9.37.
- IX. Claims 63-65, drawn to a method for suppressing HIV-1 infectivity (in vivo) comprising contacting a cell of the subject with the peptide, are classified in class 514, subclass 2, class 424, subclasses 185.1, 188.1, 9.322 and 9.37.

The inventions are distinct, each from the other because of the following reasons:

Invention I is related to Inventions II – IX as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptide can be immobilized in proteinchip array to investigating signal transduction pathway, for example.

Inventions II, III, IV, V, VI, VII, VIII and IX are directed to different and/or distinct methods. Although there are no provisions under the section for “Relationship of Invention” in MPEP 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper between the methods of Inventions II - IX since they constitute patentably distinct inventions comprising methodologies, objectives (e.g., *in vitro* or *in vivo*), method steps, targets, administering route, and treatment outcome.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their different classification, art recognized divergent subject matter, separate search, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is 703-306-3483. The examiner can normally be reached Monday-Friday 9:00 -5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communication and (703) 305-3014 for the after final communication. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

*SWL*

Samuel Wei Liu, Ph. D.

April 16, 2003

*Karen Cochrane Carlson PhD*

KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER